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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,705	12/13/2004	Hirofumi Masuda	1600-0157PUS1	9097

2292 7590 05/30/2008  
BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
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BERNSHTEYN, MICHAEL

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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05/30/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/517,705	<b>Applicant(s)</b> MASUDA ET AL.	
	<b>Examiner</b> MICHAEL M. BERNSHTEYN	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 6-25 is/are pending in the application.
- 4a) Of the above claim(s) 10-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,6-9 and 23-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1,3 and 6-25 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This Office Action follows a response filed on February 14, 2008. Claims 1 and 3 have been amended; claims 2, 4 and 5 have been cancelled; claims 23-25 have been added.
2. Claims 1, 3, 6-9 and 23-25 are active.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 24 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 24 and 25 recite new limitation that the acrylic rubber is insoluble in water. The specification does not describe this limitation, and one skilled in the relevant art that the inventor(s), at the time the application was filed, had no possession of the claimed invention.

### ***Claim Rejections - 35 USC § 103***

4. The text of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.

5. Claims 1, 3, 5, 7 and 8 are rejected under U.S.C. 103(a) being unpatentable as obvious over Linke et al. (U. S. patent 3,981,987), for rationale recited in paragraph 6 of Office Action dated on August 20, 2007.

6. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable as obvious over Linke et al. (U. S. Patent 3,981,987) in view of Moriyama et al. (U.S. Patent Application Publication 2001/0005742), ), for rationale recited in paragraph 7 of Office Action dated on August 20, 2007.

7. Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable as obvious over Linke et al. (U. S. Patent 3,981,987).

With regard to the limitation of instant claim 23, Linke discloses a copolymer of a) from 20 to 95% by weight of at least one compound selected from the group consisting of vinyl esters of aliphatic carboxylic acids of 2 to 20 carbon atoms and esters of acrylic and methacrylic acid with aliphatic alcohols of 1 to 6 carbon atoms, and b) from 80 to 5% by weight of at least one compound selected from the group consisting of the half-esters of ethylenically unsaturated dibasic carboxylic acids of 4 to 5 carbon atoms with aliphatic alcohols of 6 to 24 carbon atoms (claim 1, col. 8, line 62 through col. 9, line 5).

It should be mentioned that Linke clearly disclose that the stated ratios of the component (a) and (b) can be chosen in accordance with the particular desired mode of action of the composition (col. 4, lines 13-15).

Linke does not disclose that the acrylic rubber comprised of a copolymer comprising 0.1 to less than 5% weight of (A) units of the monomer selected from the group consisting of monocyclohexyl fumarate and monocyclohexyl maleate.

It is worth to mention that a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Court held as proper a rejection of a claim directed to an alloy of “having 0.8% nickel, 0.3% molybdenum, up to 0.1% iron, balance titanium” as obvious over a reference disclosing alloys of 0.75% nickel, 0.25% molybdenum, balance titanium and 0.94% nickel, 0.31% molybdenum, balance titanium.). “[A] prior art reference that discloses a range encompassing a somewhat narrower claimed range is sufficient to establish a *prima facie* case of obviousness.” *In re Peterson*, 315 F.3d 1325, 1330, 65 USPQ2d 1379, 1382-83 (Fed. Cir. 2003). See MPEP § 2144.05 [R-5].

Therefore, it is the Examiner position that a *prima facie* case of obviousness exists because Linke discloses the range starting with 5% while claim 23 recites “less than 5%”.

With regard to the limitation of instant claims 24 and 25, Linke does not disclose that the acrylic rubber is insoluble in water.

However, in view of substantially identical composition between Xu and instant claims, it is the examiner position that Linke’s composition possesses this property. Since the USPTO does not have equipment to do the analytical test, the burden is now shifted to the applicant to prove otherwise. *In re Best*, 195 USPQ 430, (CCPA 1977).

Even assuming that the claims are not anticipated by the reference, it would have been obvious to one of ordinary skill in the art to make the polymer having the claimed

property because it appears that the reference generically embrace the claimed subject matter and the person of ordinary skill in the art would have expected all embodiments of the reference to work. Applicants have not demonstrated that the differences, if any, between the claimed subject matter and the subject matter of the prior art examples give rise to unexpected products.

### ***Response to Arguments***

8. Applicant's arguments filed on February 14, 2008 have been fully considered but they are not persuasive.

9. It appears that the focal Applicants argument resides in the contention that The polymeric resin in Linke et al is water-soluble and the hair-setting composition can form a film on hair which can be washed off with water (claim 1; column 2, line 2 et seq.; column 3, lines 63-69; and column 4, 16-31). In contrast, the acrylic rubber of the present invention is used for sealers, cylinder head covers, automobile hoses and industrial hoses, vibration insulators, tubes, belts and boots. Thus, the acrylic rubber must not be soluble in water (page 7).

10. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the acrylic rubber of the present invention is used for sealers, cylinder head covers, automobile hoses and industrial hoses, vibration insulators, tubes, belts and boots) are not recited in the rejected claim(s). Although the claims are interpreted in light of the

Art Unit: 1796

specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

11. In response to applicant's argument that Linke et al. teach that the component (b) including cyclohexyl maleate has a function of giving a water-soluble copolymer so that the hair-setting composition is capable of forming a film on hair which can be washed off with water, and in contrast, the component (A) of the present invention is crucial for giving different specific properties (page 8, 2<sup>nd</sup> paragraph), see current Office action (paragraphs 3 and 10).

12. In response to applicant's argument that there is no motivation for the skilled artisan to combine Moriyama et al with Linke et al disclosing hair-setting composition capable of forming a film on hair which can be washed off with water (page 9, 2<sup>nd</sup> paragraph), it is noted that "The motivation in the prior art to combine references does not have to be identical to that of the applicant to establish obviousness, i.e. it is not required for a finding of obviousness that motivation of the skilled artisan be the same as an applicant motivation", *In re Kemps*, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1312 (Fed. Cir. 1996) (holding there is sufficient motivation to combine teachings of prior art to achieve claimed invention where one reference specifically refers to the other).

Therefore, it is well settled that for a finding of obviousness under § 103 the prior art need not disclose the same motivation as disclosed by an applicant.

13. In response to applicant's arguments that the polymeric resin in Linke et al is water-soluble and the hair-setting composition can form a film on hair which can be washed off with water (page 7, 3<sup>rd</sup> paragraph), it is noted that Linke does not disclose

Art Unit: 1796

that polymeric resin is water-soluble. Furthermore, if the film can be washed off with water does not mean that the acrylic rubber is water-soluble, for example, sand can be washed off with water, but it is not water-soluble.

14. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### **Conclusion**



Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL M. BERNSHTEYN whose telephone number is (571)272-2411. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael M. Bernshteyn/  
Examiner, Art Unit 1796

/M. M. B./  
Examiner, Art Unit 1796

/Randy Gulakowski/  
Supervisory Patent Examiner, Art Unit 1796

Application/Control Number: 10/517,705  
Art Unit: 1796

Page 9